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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,320	04/28/2000	Michael Wayne Brown	AUS000052US1	3984

7590 01/09/2003

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/560,320

Applicant(s)  
Brown et al

Examiner  
Andrew J. Fischer

Art Unit  
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 1, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above, claim(s) 1-14, 27-37, 39, 40, 42, and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-26, 38, and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 & 4 6) ☐ Other:

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## **DETAILED ACTION**

### ***Restriction***

1. Applicants' election of Group II (claims 15-26, 38, and 41) in Paper No. 6 "with traverse" is acknowledged. However, because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP §818.03(a)).
2. Claims 1-14, 27-37, 39, 40, 42, and 43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 6.

### ***Election of Species***

3. Applicants' election with traverse of Species 1 in Paper No. 6 is acknowledged. The traversal is on the grounds that "the elected claims are generic to the species." After further review of the claims, specification, and the prior art, it is the Examiner's position that the species are not patentably distinct. Therefore, the Election of Species in Paper No. 5 is hereby withdrawn.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

a. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

b. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 15 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claims 11-18 of copending Application No. 09/560,317 ("317 Application"). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

a. Claim 11 of the '317 Application discloses: receiving food-related inventory preferences for each of a plurality of users (via the computer system disclosed in claim 11); adjusting a current database (adjusting future food-related orders); determining which items are absent (inherent in the "adjusting" clause in claim 11); such that the food-related inventory is

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managed; and claim 13 of the '317 Application discloses data exchange in an extensible mark-up language.

b. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 15-25, 38, and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Sone (U.S. 6,204,763 B1). Sone discloses a store server <sup>toilet paper</sup> (21) (or 24 shown in figure 4) acting as an inventory processor for an automated ordering system (column 9, ~ lines 32-55) or, alternatively, personal computer (50) acting as an inventory processor for an automated ordering system; receiving (transmitting) food related inventory preferences (inherent in product desired, e.g. if user prefers milk over cream the user will specify milk and not cream) for each of a plurality of users to a controller (21) (or 24 which is at store or at "at least one vendor") for a particular storage area (the refrigerated section 22B) that monitors current food-related inventory (e.g.

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milk); adjusting a current database of intended food-related inventory for the particular storage area at the controller according to the food related inventory preferences (database is changed upon refilling or having the user put the milk back in the refrigerator); determining a selection of food-related items from among the database of intended food related items that are absent from the particular storage area ("desired inventory") such that food-related inventory that is intended for the particular storage area (22B) is managed (inherent); receiving food-related inventory preferences for a plurality of users at the controller from a plurality of computer systems (e.g. 50 in figure 4); receiving food-related inventory preferences for a user from a particular storage device proffered by the particular user (e.g. <sup>11</sup>22B); the receiving is done via a universally accessible server system (the Internet) according to a particular universal identifier associated with a particular user (inherent in a user's name, address, and account number; each home user must have a unique address for delivery purposes and a unique account number for billing purposes upon automatic ordering); receiving food-related inventory preferences in an extensible mark-up language format (inherent in personal computer 50 with an Internet connection since Internet uses HTML or other XML; additional evidence of the inherency includes the modem and a display which allows the user to alter the various parameters); periodically receiving records of additions and removals of food-related items from said particular storage area (inherent, e.g. milk has a 5 day cycle); adding food-related inventory preferences to a base list of amounts (the desired inventory) of inventory in a particular storage area (when a new food-related item is added to the household inventory, column 3, ~line 52-56); adding or subtracting (adjusting and combining)

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food-related inventory preferences of previously received food-related inventory preferences for items to be maintained in a particular storage area (checking to see if there was an additional order “independent of the inventory processor,” column 9, ~ lines 36-40 so that all orders are sent out together; or alternatively, has the item been removed from the order list; column 8, ~ lines 50-54); a delivery person receives a request from a particular store (for the delivery of the ordered goods); enabling access to the selection of food-related items that are absent from the particular storage area if a store is included in a plurality of allowable requesters for the particular storage area (multiple vendors with access via security controls; in other words, multiple vendors are inherent in the “at least one vendor” with authorized access, authorized access is itself inherent since some security control *must* exist because the connection is Internet based); and both the store shopping server 24 and personal computer (50) are portable (inherent since they can be moved).

8. It is the Examiner’s principle position that its inherent in Sone that the automatic replenishment system is used in a plurality of homes (or households).

a. Because Sone discusses prior art systems in “commercial establishments” yet not appreciated in the home environment (column 2, ~ lines 8-13), Sone inherently discloses the use of the system in a plurality of homes. Additionally evidence of the inherency is that it would be impractical for a vendor to provide the service to a single home.

b. Moreover, Sone column 2, ~ lines 33-35 states, “More particularly, the present invention comprises *a household* consumable item automatic replenishment system and method . .

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... [Emphasis added.]” “It is well settled that the term ‘a’ or ‘an’ ordinarily means one or more.”

*Tate Access Floors Inc. v. Interface Architectural Resources Inc.*, 279 F.3d 1357, 1370, 61

USPQ2d 1647, 1657 (Fed. Cir. 2002). Therefore, “a household” noted above is interpreted to mean one or more households.

9. Functional recitations using the word “for” (e.g. “for managing inventory” as recited in claim 15) have been given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

10. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and



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customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).<sup>1</sup>

In accordance with the ordinary and accustom meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>2</sup>

However, if Applicants wish to use lexicography and desire a claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicants in their next response to expressly indicate<sup>3</sup> the claim limitation at issue<sup>4</sup> and to show

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<sup>1</sup> It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

<sup>2</sup> See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

<sup>3</sup> “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

<sup>4</sup> “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

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where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).<sup>5</sup> The Examiner cautions that no new matter is allowed.

Failure by Applicants in their next response to address this issue or to be non-response to this issue entirely will be considered a desire by Applicants to forgo lexicography and to continue having the claims interpreted with their ordinary and accustomed meaning and with their broadest reasonable interpretation. Additionally, it is the Examiner’s position that above requirements are reasonable.<sup>6</sup> Applicants are also cautioned that even though claim interpretation begins with this

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<sup>5</sup> See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

<sup>6</sup> The requirements are reasonable on at least two separate and independent grounds: first, the Examiner’s requirements are simply an express request for clarification of how Applicants intend their claims to be interpreted. Second, the requirements are reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21<sup>st</sup> Century Strategic Plan, June 3, 2002 available at [www.uspto.gov/web/offices/com/strat2001/index.htm](http://www.uspto.gov/web/offices/com/strat2001/index.htm).

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presumption, after issuance the prosecution history may further limit claim scope if Applicants disclaim or disavow a particular interpretation of the claims during prosecution. *Abbott Laboratories v. TorPharm Inc.*, 300 F.3d 1367, 1372, 63 USPQ2d 1929, 1931 (Fed. Cir. 2002).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 15-25, 38, and 41 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Sone.<sup>7</sup> It is the Examiner's principle position that use of the automatic replenishment system in multiple homes (or households) is inherent in Sone and therefore anticipated as noted above.

Alternatively, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sone to include the system in multiple homes. Such a modification would have made system profitable for the vendors and delivery persons since they would never make money if the system was for a single home.

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<sup>7</sup> See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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Furthermore, the placement of the automatic replenishment system in multiple homes is merely duplicating an easily delineated and expressly described embodiment in Sone. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. See MPEP §2144.04 VI *B* or *In re Harza*, 47 CCPA 771, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

13. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sone in view of Salvo et. al. (U.S. 6,341,271) (“Salvo”). Sone discloses as discussed above but does not directly disclose receiving the request *from the store* for the selection of food-related items that are absent from the particular storage area. Additionally, Sone does not disclose much in terms of vendor side operations in the disclosed system.

Salvo directly teaches initiating the request by the vendor (vendor managed inventory). Salvo’s vendor managed inventory system has the vendor initiating the request (column 9, ~ lines 37-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sone as taught by Salvo and include various aspects of Salvo’s vendor managed inventory system to the vendor side of Sone. In particular, this would include Salvo’s vendor management tools (some of which are noted above in the cited passage). Such a modification would have further reduced delays, costs of ordering, and inventory turn around times.

Additionally, the modification would have helped synchronize inventory ordering and delivery so that food-related items are not out of stock in the home. For example, suppose milk

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inventory becomes low in a particular home every Saturday morning because children in the home are having cereal with milk while watching cartoons. Using the vendor's historical trend analysis tool as implemented in Salvo, automatic ordering and subsequent delivery of milk could occur every Saturday afternoon.

14. Moreover, it is the Examiner's position that all claimed features in claims 15-26, 38 and 41 are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)).

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Brown et. al. (U.S. 6,430,541 B1); Rosenberg et. al. (U.S. 6,418,416 B1); Johnson et. al. (U.S. 6,023,683); Horne et. al. (U.S. 5,091,713); and Bianco (U.S. 5,047,614).

16. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

17. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has

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provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicants disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>8</sup> the Examiner respectfully requests Applicants *in their next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

  
ANDREW J. FISCHER  
PATENT EXAMINER

AJF  
January 6, 2003

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<sup>8</sup> E.g., if the Examiner rejected a claim under §103, although not directly stated, it is the Examiner's implied position that the references are analogous art.